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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,958	09/29/2000	Laura Lee Kusumoto	13376.0001	1238

26694 7590 06/15/2004

VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER	
OUELLETTE, JONATHAN P	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/675,958	KUSUMOTO ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *65-153* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *65-153* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILEDACTION

Response to Amendment

1. Claims 1-64 have been cancelled, and claims 65-153 have been added; therefore, Claims 65-153 are currently pending in application 09/675,958.

Applicant Fees

2. Applicant correct Fee Transmittal is acknowledged.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 65-70, 72-74, 78-80, 83-95, 97-99, 103-105, 108-120, 122-124, 128-130, 133-143, 145-148, and 152-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (US 6,036,601) in view of Gever et al. (US 6,329,994 B1).**

5. **As per independent Claims 65, 90, and 115**, Heckel discloses a method (system, computer program product) for advertising and branding in a virtual world, comprising: providing one or more advertisements to a participant; providing one or more locations

for the display of said advertisements in a virtual world; creating ad content from said at least one selection; and providing said ad content in said virtual world (abstract).

6. Heckel fails to expressly disclose receiving at least one selection of said one or more advertisements and said one or more locations from said participant.
7. However, Gever teaches creating a virtual character (avatar), wherein the users can personalize their character by selecting clothing and logos to wear on the clothing (C18 L39-67, *C19 L1-3*).
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving at least one selection of said one or more advertisements and said one or more locations from said participant, as disclosed by Gever in the system disclosed by Heckel, for the advantage of providing a method of advertising to participants and viewers in a virtual world, with the ability to increase brand awareness and brand imaging by allowing users to select and display the advertisements (brand) on their avatars.
9. As per Claims 66, 91, and 116, Heckel and Gever disclose wherein said participant creates at least one of said one or more advertisements (logo).
10. As per Claims 67, 92, and 117, Heckel and Gever disclose wherein said participant's creation of said one or more advertisements is provided in at least one of said virtual world, or one or more ancillary support environments.
11. As per Claims 68, 93, and 118, Heckel and Gever disclose wherein said participant's selection of said one or more advertisements and said one or more locations is provided in at least one of said virtual world, or one or more ancillary support environments.

12. As per Claims 69, 94, and 119, Heckel and Gever disclose tracking one or more activities of said participant in said virtual world.

13. As per Claims 70, 95, and 120, Heckel and Gever disclose wherein said one or more activities includes at least one of computer games, video games, online chat, instant messaging, or one or more virtual scenes.

14. As per Claims 72, 97, and 122, Heckel and Gever disclose wherein said tracking includes at least one of (a) collecting information on said participant, (b) collecting information on said one or more advertisements included in said ad content for said participant, or (c) collecting display information on the manner in which said one or more advertisements are displayed to at least one from a first group of participants, users, or viewers in said virtual world.

15. As per Claims 73, 98, and 123, Heckel and Gever disclose wherein display information includes at least one of (i) a measured display time of said one or more advertisements to said at least one from said first group, (ii) a number of said first group that viewed said one or more advertisements, (iii) anticipated display time of said one or more advertisements to said at least one from said first group, (iv) said one or more locations of each of said one or more advertisements, or (v) information on exposure of said first group to said one or more advertisements.

16. As per Claims 74, 99, and 124, Heckel and Gever fail to expressly disclose rewarding said participant with one or more rewards based on said tracking of said one or more activities.

17. However, Heckel does teach tracking the viewing statistics of advertisements on users in the virtual world, wherein the adserver then uses the statistical information to for billing the advisor (C3 L4-16).

18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included rewarding said participant in connection with activities identified in said tracking step, in the system disclosed by Heckel in view of Gever, for the advantage of providing a method of advertising to participants and viewers in a virtual world, with the ability to increase customer interaction with the advertising process by offering a tangible incentive.

19. As per Claims 78, 103, and 128, Heckel and Gever disclose wherein said virtual world is implemented by interactive media.

20. As per Claims 79, 104, and 129, Heckel and Gever disclose wherein said interactive media is provided by at least one of (a) a second group of one or more servers and one or more databases, or (b) interactive television.

21. As per Claims 80, 105, and 130, Heckel and Gever disclose wherein said one or more advertisements are displayed at least at one of (i) times designated by said participant, or (ii) predetermined times.

22. As per Claims 83, 108, and 133, Heckel and Gever disclose logging said one or more activities of said participant and said first group.

23. As per Claims 84, 109, and 134, Heckel and Gever disclose wherein said logging is performed in said second group.

24. As per Claims 85, 110, and 135, Heckel and Gever disclose reporting to an advertiser said one or more activities about said one or more advertisements.

25. As per Claims 86, 111, and 136, Heckel and Gever disclose wherein said one or more advertisements are created by said advertiser.

26. As per Claims 87, 112, and 137, Heckel and Gever disclose wherein said one or more advertisements are provided by said advertiser.

27. As per Claims 88, 113, and 138, Heckel and Gever disclose wherein said one or more advertisements are provided by said participant and approved by said advertiser.

28. As per Claims 89, 114, and 139, Heckel and Gever disclose billing said advertiser in connection with said one or more activities.

29. **As per independent Claim 140**, Heckel discloses a system for advertising and branding in a virtual world comprising: one or more servers with access to a computer network to communicate with one or more participants via one or more clients with access to said computer network; a consumer database to store consumer profiles of said one or more participants in said virtual world (abstract, C4 L35-68); and a presentation tracking database to store display information of said one or more advertisements (C3 L4-16, C5 L1-40).

30. Heckel fails to expressly disclose wherein said one or more servers provide said one or more participants with a selection of one or more advertisements (logos) and one or more locations for the display of said one or more advertisements in a virtual world and an advertising database to store identification for one or more advertisements available for selection by said one or more participants.

31. However, Gever teaches creating a virtual character (avatar), wherein the users can personalize their character by selecting clothing and logos to wear on the clothing from a database (C18 L39-67, *C19 L1-3*).

32. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein said one or more servers provide said one or more participants with a selection of one or more advertisements (logos) and one or more locations for the display of said one or more advertisements in a virtual world and an advertising database to store identification for one or more advertisements available for selection by said one or more participants, as disclosed by Gever in the system disclosed by Heckel, for the advantage of providing a method of advertising to participants and viewers in a virtual world, with the ability to increase brand awareness and brand imaging by allowing users to select and display the advertisements (brand) on their avatars.

33. As per Claim 141, Heckel and Gever disclose wherein said computer network provides access to a virtual world.

34. As per Claim 142, Heckel and Gever disclose a billing system to generate billing information with access to said display information on said presentation tracking database (Heckel: abstract, C2 L46-58, C3 L4-16, C4 L35-68, C5 L1-40).

35. As per Claim 143, Heckel and Gever disclose wherein said display information includes at least one of (i) a measured display time of said one or more advertisements to at least one of a first group of participants, users, or viewers in said virtual world, (ii) the number of said first group that viewed said one or more advertisements, (iii) anticipated display

time of said one or more advertisements to said first group, (iv) a size of each of said one or more advertisements, or (v) a location of each of said one or more advertisements.

36. As per Claim 145, Heckel and Gever disclose wherein said one or more servers receives at least one new advertisement in addition to said one or more advertisements in said advertisements database.

37. As per Claim 146, Heckel and Gever disclose wherein said new advertisements is received from one of said one or more participants.

38. As per Claim 147, Heckel and Gever fail to expressly disclose wherein said one or more servers provides rewards to said one or more participants based upon said display information.

39. However, Heckel does teach tracking the viewing statistics of advertisements on users in the virtual world, wherein the adserver then uses the statistical information to for billing the advisor (C3 L4-16).

40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included rewarding said participant in connection with activities identified in said tracking step, in the system disclosed by Heckel in view of Gever, for the advantage of providing a method of advertising to participants and viewers in a virtual world, with the ability to increase customer interaction with the advertising process by offering a tangible incentive.

41. As per Claim 148, Heckel and Gever disclose wherein said one or more advertisements are displayed at least at one of (i) time designated by said participant, or (ii) predetermined times.

42. As per Claim 152, Heckel and Gever disclose wherein said virtual world is implements by interactive media.

43. As per Claim 153, Heckel and Gever disclose wherein said interactive media is provided by interactive television.

44. **Claim 71, 75-77, 81-82, 96, 100-102, 106-107, 121, 125-127, 131-132, 144, 149-151 is rejected under 35 U.S.C. 103 as being unpatentable over Heckel in view of Gever.**

45. As per Claims 71, 96, and 121, Heckel and Gever fail to expressly show wherein said virtual scenes *include* a dance, party, sporting event, gambling event, meeting, shopping mall, town square, trade show, rally, conference, life simulation, or fantasy simulation.

46. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The virtual advertising system would be performed regardless of the type of virtual scene used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

47. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a virtual scene that included one of: a dance, party, sporting event, gambling event, meeting, shopping mall, town square, trade show, rally, conference, life simulation, or fantasy simulation, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

48. As per Claims 75, 100, and 125, Heckel and Gever fail to expressly show wherein said one or more rewards include at least one of coupons, merchandise, credits, goods, services, information about said virtual world, opportunities in said virtual world, real money, or virtual money.

49. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The virtual advertising system would be performed regardless of the type of reward used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

50. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a reward that included one of: coupons, merchandise, credits, goods, services, information about said virtual world, opportunities in said virtual world, real money, or virtual money, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

51. As per Claims 76, 101, 126, and 144, Heckel and Gever fail to expressly show wherein said consumer profile includes at least one of (a) registration information, (b) environment continuation information to allow said one or more participants to continue where said one or more participants previously left in said virtual world, (c) ad content for each of said first group, (d) tracking information, (e) reward information, or (f) said display information on one or more activities of each of said first group.

52. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The virtual advertising system would be performed regardless of what the consumer profile included. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

53. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included with the consumer profile at least one of (a) registration information, (b) environment continuation information to allow said one or more participants to continue where said one or more participants previously left in said virtual world, (c) ad content for each of said first group, (d) tracking information, (e) reward information, or (f) said display information on one or more activities of each of said first group, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

54. As per Claims 77, 102, 127, and 151, Heckel and Gever fail to expressly show wherein said one or more advertisements are located on at least one of an avatar, a virtual space, or a virtual object of said participant within said virtual world.

55. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The virtual advertising system would be performed regardless of where the advertisements are located. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

56. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have place the advertisements on at least one of an avatar, a virtual space, or a virtual object of said participant within said virtual world, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

57. As per Claims 81, 106, 131, and 149, Heckel and Gever fail to expressly show wherein said one or more advertisements include at least one of a third group of (a) text, (b) symbols, (c) graphic, (d) graphics that are texture-mapped in said virtual world, or (e) multimedia elements of audio, video, and animation.

58. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The virtual advertising system would be performed regardless of what the advertisements included. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

59. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included with the advertisements at least one of (a) text, (b) symbols, (c) graphic, (d) graphics that are texture-mapped in said virtual world, or (e) multimedia elements of audio, video, and animation, because such data does not

functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

60. As per Claims 82, 107, 132, and 150, Heckel and Gever fail to expressly show wherein said one or more advertisements include at least one of a forth group of (a) corporate symbols, (b) logos, (c) trademarks, (d) advertising text or copy, (e) graphical pictures, or (f) multimedia elements.

61. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The virtual advertising system would be performed regardless of what the advertisements included. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

62. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included with the advertisements at least one of (a) corporate symbols, (b) logos, (c) trademarks, (d) advertising text or copy, (e) graphical pictures, or (f) multimedia elements, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

63. Applicant's arguments filed on 3/17/2004, with respect to claims 1-64 have been considered but are moot in view of the new ground(s) of rejection.

64. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

65. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

66. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

67. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

68. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
June 14, 2004

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600